

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

JAMES

Serial No.: 09/029,581

Filed: March 6, 1998

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Atty. Ref.: 36-1116

Group Art Unit: 2171

Examiner: Mills, J.

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**REPLY BRIEF**

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

Appellant hereby submits this Reply Brief under the provisions of 37 CFR 1.193(b) in response to the Examiner's Answer of January 16, 2001, paper no. 16.

70102-3 112-29  
APPEAL BRIEF  
EXAMINER'S ANSWER

**WHETHER THE CLAIMS STAND OR FALL TOGETHER**

In the Appeal Brief, Appellant set forth the following groups of claims:

Claims 1 and 4 stand or fall together and do not stand or fall with any other claims.

Claims 2 and 8 stand or fall together and do not stand or fall with any other claims.

Claim 3 stands or falls alone and does not stand or fall with any other claims.

Claim 5 stands or falls alone and does not stand or fall with any other claims.

Claim 6 stands or falls alone and does not stand or fall with any other claims.

Claim 7 stands or falls alone and does not stand or fall with any other claims.

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The Examiner's Answer states (page 3, lines 1-3),

"The rejection of claims 1-8 stand (sic) or fall together because Appellant's brief does not include a statement that this grouping of claims does not stand or fall together and *reasons in support thereof*. See 37 CFR 1.192(c)(7)."

It appears that there is no dispute that Appellant has provided a statement regarding what is believed to be the proper grouping of claims. Accordingly, Appellant believes that the Examiner's position that the rejection of claims 1-8 stands or falls together (as opposed to the grouping presented by Appellant) is based upon the allegation that Appellant has not provided reasons in support of his grouping of claims. If this is not the case, Appellant respectfully requests clarification thereof.

Appellant respectfully submits that the grouping of claims presented in the Appeal Brief is proper. Reasons in support of the grouping of claims presented in the Appeal Brief are readily apparent in the section entitled "Arguments With Respect To The Issues Presented For Review" (pages 6-12 of the Appeal Brief). Specifically, reasons in support of the following groups of claim(s) standing or falling alone (or together where there are multiple claims in one group) and not standing or falling with any other claims can be found, for example, at the following locations of the Appeal Brief:

<i>Claim(s)</i>	<i>Location in Appeal Brief</i>
1 and 4	Page 6, line 11 to page 10, line 20
2 and 8	Page 6, line 11 to page 10, line 14 and page 10, line 21 to page 11, line 2
3	Page 11, lines 3-8
5	Page 11, lines 11-22
6	Page 12, lines 1-4
7	Page 11, lines 3-8

Accordingly, Appellant respectfully submits that reasons in support of the grouping of claims have been provided and therefore the grouping of the claims presented in the Appeal Brief is proper.

**ARGUMENTS WITH RESPECT TO THE ISSUES PRESENTED FOR REVIEW**

In the Appeal Brief, Appellant provided arguments regarding why claims 1-8 are patentable under 35 U.S.C. §102(e) as not having been anticipated by Brunner et al. (U.S. Patent 5,550,971). It appears that no new argument has been specifically presented in the Examiner's Answer with respect to Brunner et al. Indeed, the Examiner's Answer states, "Only the discussion of prior art referenced by the applicant in his brief has been added to this rejection." (See page 3, lines 8-9 of the Examiner's Answer.) Accordingly, Appellant maintains his position that claims 1-8 are patentable under 35 U.S.C. §102(e) as not having been anticipated by Brunner et al. for the reasons discussed in detail in the Appeal Brief.

The Examiner's Answer presents the new argument that "The applicant's brief additionally admits that the features of the applicant's claims are shown by the prior art." (See page 5, lines 8-20 of the Examiner's Answer.) Appellant respectfully disagrees that the Appeal Brief admits that the features of the claims are shown by the prior art and submits that any allegation to the contrary is based on a misreading and/or misunderstanding of the Appeal Brief.

In the section entitled "Concise Explanation Of The Invention" of the Appeal Brief, Appellant contrasts Figure 5 describing the prior art and Figure 6 describing the present invention. The contrast between Figure 5 and Figure 6 is highlighted on page 4, line 21 to page 5, line 3 of the Appeal Brief which states the following:

"In the procedure of Fig. 6 illustrating the present invention, steps 600 to 620 are equivalent to steps 500 to 520 of prior art Fig. 5. However, in step 625, the file server 100 compares the key in the index entry of the requested data row 210 with the key of the cached data row 235 as received in the query. Thus, the key of an index entry is read and used in the comparison in step 625 of the present invention rather than the key of a row from the master database 126 as in prior art Fig. 5."

The Appeal Brief thus describes that certain features of the claims are not shown by the prior art. Even the Examiner's Answer recognizes that there is at least a "slight distinction" (see page 5, lines 13-16) between using the key of an index entry in a comparison (as in the present invention) rather than the key of a row (as described in prior art Fig. 5). To the extent that the Examiner admits that there is a distinction at all between using the key of an index entry in a comparison rather than the key of a row, the Examiner contradicts his allegation that the claimed invention is anticipated by any admission made in the Appeal Brief regarding the prior art.

For the foregoing reasons, Appellant respectfully submits that the Appeal Brief does not admit that the features of the claimed invention are shown by the prior art.

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CONCLUSION

For all of the reasons set forth above and for the reasons discussed in detail in the previously filed Appeal Brief, it is respectfully requested that this appeal be granted and that the rejections on appeal be reversed.

Respectfully submitted,

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